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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,443	01/29/2001	Robert Gordon	19388- P002us	1042

7590 05/14/2004

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EXAMINER

ROSALES HANNER, MORELLA I

ART UNIT	PAPER NUMBER
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2128

DATE MAILED: 05/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,443

Applicant(s)

GORDON ET AL.

Examiner

Morella I Rosales-Hanner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30)-days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. **Claim 1** is pending and has been examined.

Priority

2. Acknowledgment is made of applicant's claim from provisional application No. 60/178,435, filed on 01/27/2000.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

- 3.1 **Claim 1** is rejected under 35 U.S.C. 103(a) as being unpatentable over a printed publication from a join project involving the **Law Society of NSW, ABC online, and the British Council** titled "**Mock Trial online**", hereafter referred to as *Mock Trial*

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Online, in view of a printed publication from **eShare Technologies, Inc.** titled "**eShare Expressions – Chat Features**", hereafter referred to as *eShare* in further view of a printed publication from **First Court, Inc.** titled "**Street Smart Jury Evaluations**", hereafter refer to as *First Court*.

Claim 1 is drawn to a method of conducting a mock trial via a computer network comprising the steps of:

- developing case information for presentation to a selected group of virtual triers and selectively presenting the case information to each of the virtual triers via the computer network;
- setting up a virtual jury room for establishing communications between the group of triers using virtual jury rooms;
- setting up a virtual observation room supporting observations of selected communications among the virtual triers;
- selecting a group of virtual triers; and
- storing case information in a computer database.

The *Mock Trial Online* teaches [<http://www.abc.net.au/mocktrial/default.htm>, What is the Mock Trial Online?

Section] a method of conducting a full Mock Trial over the Internet (computer network)

comprising the steps of:

- developing case information for presentation to a selected group of virtual triers and selectively presenting the case information to each of the virtual triers via

the Internet or computer network [<http://www.abc.net.au/mocktrial/resources/roles.htm>, Solicitors section];

- setting up a mock trial forum [<http://www.abc.net.au/mocktrial/forum/forum.htm>] that is used as a virtual jury room for establishing communications between the virtual triers;
- selecting a group of virtual triers;

The *Mock Trial Online* reference does not expressly teach setting up a virtual observation room to support observation of select communications among the virtual triers; storing case information in a computer database; or selecting a group of virtual triers.

The *eShare* reference teaches an **eShare Expressions Interaction Suite product** [<http://web.archive.org/web/19990427234417/www.eshare.com/products/expressionsmain.html>] for adding chat, threaded discussion forums and online presentations to web sites and that it can be used for virtual meetings and moderated events. The *eShare* reference further teaches specific chat supporting features such as:

- ODBC Forum Support used for storing **all forum data** in an ODBC-compliant computer database along with a database application programming interface to simplify interaction to the computer database
[<http://web.archive.org/web/19990427050636/www.eshare.com/exp4features.html>];
- Improved chat rooms for creating public, private, password-protected, moderated virtual rooms (observation rooms) for observation of selected communications among audience members.

[<http://web.archive.org/web/19990508005118/www.eshare.com/products/exp-chat.html>, Improved rooms – “Back Stage” for event managers features]

The *First Court* reference teaches [<http://web.archive.org/web/19991011015547/http://www.firstcourt.com>, paragraphs 2 - 4] a fast and affordable method of conducting mock trials to obtain confidential, insightful jury deliberation to minimize unexpected bad trial outcomes. The *First Court* reference further teaches [http://web.archive.org/web/19991109093143/www.firstcourt.com/why_so_easy.html, paragraphs 2 – 5] a Case Presentation Package (case information) that is developed for presentation to a selected group of jurors (triers) [http://web.archive.org/web/19991109093143/www.firstcourt.com/why_so_easy.html], Where do you get your juror?].

It would has been obvious to one of ordinary skills in the art, at the time of the invention, to modify the methodology for conducting mock trial online taught by the *Mock Trial Online* reference to use jurors (virtual triers) as taught by the *First Court* in a moderated online environment as taught by the *eShare* reference in order to provide a fast and affordable method of conducting mock trials to obtain confidential, insightful jury deliberation information to minimize unexpected bad trial outcomes.

4. Additional references

The following is a list of references that are relevant to the claimed invention but were not cited by the examiner:

- US Patent No. 5,948,022 issued to Carleton et al. Sep 7, 1999
- US Patent No. 5,895,450 issued to Marshall A. Sloo Apr 20, 1999

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- US Patent No. 5,748,894 issued to Ishizaki et al. May 5, 1998
- US Patent No. 5,999,208 issued to McNerney et al. Dec. 7, 1999
- US Patent No. 6,370,533 issued to Sato et al. Apr 9, 2002
- Product literature for DigiChat from Digi-net Technologies, Inc.
http://web.archive.org/web/19991013073812/digichat.com/PI_featureSet.html
http://web.archive.org/web/19991013073812/digichat.com/PI_featureSet.html
- Product literature from iCourthouse Inc.
<http://web.archive.org/web/19991128214616/www.i-courthouse.com/main.taf>
- William E. Boyd, Winton D. Wood, Mark Adkins, Daniel Mittleman; "Investigating the Impact of Advanced Technology on Trials:The Courtroom as a Classroom", Proc. 29th Annual Hawaii International Conference on System Science - 1996
- Fredric I. Lederer, "The Road to the Virtual Courtroom?Consideration of Today's - and Tomorrow's - High Technology Courtrooms", Sixth National Court Technology Conference, Sep 14-16, 1999.
- Robin Widdison, "Beyond Woolf: The Virtual Court House", Web ournal of Current Legal Issues, 1997.
- Melissa Sue Glynn, Jeannette Quintana, Debra Cunningham, Dr. Sam Cooper, "GSS For Jury Deliberations: Applying Technology in the High School Courtroom", IEEE, 1998.

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Any inquiry concerning this communication or earlier communication from the examiner should be directed to Morella Rosales-Hanner whose telephone number is (703) 305-8883. The examiner can normally be reached Monday-Friday from 7:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Teska can be reached on 703 305-9704. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

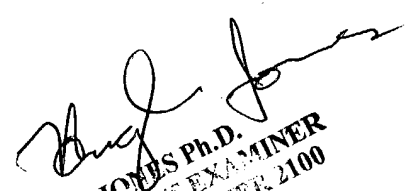
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Morella Rosales-Hanner

Assistant Patent Examiner

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May 10, 2004


HUGH JONES Ph.D.
PRIMARY PATENT EXAMINER
TECHNOLOGY CENTER 2100